

Application No.: 09/961,091

Case No.: 54404US008

**Remarks**

The specification has been amended as requested in the Office Action. Specifically, a paragraph making specific reference to the prior applications from which the present application seeks priority benefit has been added to page 1; the typographical errors on page 6, page 9, and page 16 have been corrected; and the Abstract of the Disclosure has been titled as such. No new matter is introduced by any of these amendments.

The specification also has been amended to refer to reference signs shown in the figures. No new matter is introduced into the application by these amendments.

Claims 36-60 are pending and remain under consideration.

**Remaining objection to the specification**

The specification is further objected to as failing to provide antecedent basis for the claimed subject matter. Correction was requested with regard to the phrase "and combinations thereof" in claim 43 and the phrase "or any combination of any of the foregoing" in claim 57. Claim 43 relates to thermoplastic materials that may be suitable for use in articles of the present invention; description of the materials may be found at page 9 in the paragraph beginning at line 1. Claim 57 relates to medicaments that may be used in performing certain methods of the present invention, description of which may be found on page 31 in the paragraph beginning at line 12.

Applicants submit that the specification provides adequate support for the full scope of the subject matter of each claim. In both cases, Applicants' disclosure provides lists of exemplary materials using open-ended, inclusive language. Nothing in Applicants' disclosure limits the description of suitable materials – whether thermoplastic materials or medicaments – to solely the listed materials to the exclusion of combinations of the listed materials. Furthermore, one of ordinary skill in the art would have known that (a) suitable thermoplastic materials could be formed from combinations of the listed materials, and (b) medicaments can be combined in a medical article. Consequently, the full scope of the claimed subject matter is supported by the specification.

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**§ 102 Rejections**

Claims 36-39, 41-44, 46, 48, 51-55, and 58, of which claims 36 and 51 are independent, stand rejected under 35 USC § 102(b) as being anticipated by U.S. Patent no. 5,514,210 ("Johnston"). Johnston is said to disclose all of the features of the present invention. Applicants respectfully traverse the rejection.

Claim 36 recites a medical treatment article comprising at least one fluid control film component having at least one microstructure-bearing surface with a plurality of channels therein that permit transport of fluid between a medical treatment site and *a remote area*. (emphasis added).

Claim 51 recites method of using a medical article comprising at least one fluid control film component having at least one microstructure-bearing surface with a plurality of channels therein that permit transport of fluid between a medical treatment site and *a remote area*, the method comprising (a) placing the medical article in proximity to a medical treatment site so that the fluid control film component is capable of providing fluid communication between the medical treatment site and the *remote area*; and (b) allowing the medical treatment article to transport fluid between the medical treatment site and the *remote area*. (emphasis added).

Specifically, Applicants submit that Johnston fails to disclose (a) articles that permit fluid transport to a remote area, as required by claim 36, or (b) methods that include fluid transport to a remote area, as required by claim 51. The parent of the present application – U.S. Ser. No. 09/235,720, now U.S. Patent No. 6,420,622 – was similarly rejected over Johnston, but the claims of that application were ultimately allowed after Applicants made it clear that Johnston fails to disclose articles and methods including fluid transport to a remote area. In an interview summary relating to a telephonic interview conducted June 4, 2001, the Examiner stated,

"Applicant's representative stated that Johnston et al. [U.S. Patent No. 5,514,120] did not disclose 'a fluid reservoir including absorbent material positioned remote from the fluid handling portion.' The examiner reviewed the Johnston et al. reference and agreed with Applicant's representative arguments."

The Notice of Allowance included the following statement in the Reason for Allowance:

"....Johnston et al. further disclose the management member as having a fluid reservoir including an absorbent article. Johnston et al. *fail to teach the absorbent member is positioned remote from the fluid handling portion to*

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permit fluid transfer between the absorbent material and the end portion of the fluid control film." (emphasis added).

Each of claims 36 and 51 contains a limitation relating to the concept of fluid transport between the medical treatment site and the remote area – the same concept that was acknowledged in the parent case to be absent from the teachings of Johnston. Consequently, Applicants submit that Johnston cannot anticipate either of claim 36 or claim 51.

Each of claims 37-39, 41-44, 46, and 48 depends from claim 36 and, therefore, cannot be anticipated by Johnston for at least all of the reasons set forth above regarding the failure of Johnston to anticipate claim 36. Each of claims 52-55 and 58 depends from claim 51 and, therefore, cannot be anticipated by Johnston for at least all of the reasons set forth above regarding the failure of Johnston to anticipate claim 51.

Withdrawal of the rejection of claims 36-39, 41-44, 46, 48, 51-55, and 58 under 35 U.S.C. § 102(b) as being anticipated by Johnston is respectfully requested.

### **§ 103 Rejections**

Claims 47, 49, 50, 56, 57, 59, and 60 stand rejected under 35 USC § 103(a) as being unpatentable over Johnston.

Applicants submit that the present rejection fails to establish a *prima facie* case of obviousness. § 706.02(j) of the M.P.E.P. states that a rejection under 35 U.S.C. § 103 should set forth in the Office Action:

- (1) the relevant teaching of the prior art relied upon;
- (2) the difference(s) in the claim over the applied reference(s);
- (3) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter; and
- (4) an explanation of why such proposed modification would have been obvious to one of ordinary skill in the art at the time the invention was made.

Further, in order to establish a *prima facie* case of obviousness, three basic criteria must be met:

- (1) there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference;

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(2) there must be a reasonable expectation of success; and

(3) the prior art reference must teach or suggest all of the claim limitations.

In particular, Applicants submit that Johnston fails to teach or suggest all of the claim limitations recited in the rejected claims. The failure of Johnston to disclose all of the claim limitations of claims 36 and 51 has been discussed above with regard to the rejection of claims under 35 U.S.C. § 102(b). Each of claims 47, 49, and 50 depends from claim 36; consequently, Johnston cannot teach or suggest all of the limitations of claims 47, 49, and 50. Each of claims 56, 57, 59, and 60 depends from claim 51; consequently, Johnston cannot teach or suggest all of the limitations of claims 59, 57, 59, and 60.

Because the cited reference fails to teach or suggest all of the claims limitations of claims 47, 49, 50, 56, 57, 59, and 60, a *prima facie* case of obviousness has not been established. Consequently, the rejection of claims 47, 49, 50, 56, 57, 59, and 60 under 35 USC § 103(a) as being unpatentable over Johnston is improper and should be withdrawn.

#### Double Patenting Rejection

Claims 36-50 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 1, 2, 6, 8, 9, 14-16, 19, 20, 25, 26, 35, and 36 of U.S. Patent No. 6,420,622. Upon indication of otherwise allowable subject matter, Applicants will provide an appropriate response in the event that this rejection is maintained.

#### Conclusion

In view of the above, Applicants submit that the application is in condition for allowance. Reconsideration of the application and allowance of the pending claims is requested.

Respectfully submitted,

7/31/2003  
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